

REMARKS

It is our understanding that claims 12-15 and 26-31 remain pending in this application, wherein claims 12, 26, 27, and 30 have been amended for reasons specifically remarked upon, below.

Preliminary items:

With respect to claim 12, in a Response on 08/03/2007 (to the Action dated 03/07/2007) the following amendment was made:

12 (Currently amended): A method for marketing digital content ~~on a personal computer~~, comprising ~~the steps of~~:

Then in a Response on 03/17/2008 (to the Action dated 10/31/2007) claim 12 was submitted as follows with the word “content” inadvertently omitted:

12 (Previously presented): A method for marketing digital, comprising:

This error was apparently missed by the Office. We now respectfully ask that claim 12 be correctively amended as follows:

12 (Currently amended): A method for marketing digital content, comprising:

With respect to claim 27, this was newly presented in the Response on 08/03/2007 (to the Action dated 03/07/2007) and read as follows:

27 (New): The system of claim 27, wherein:

The obvious typographical error here was also apparently missed by the Office. We now respectfully ask that claim 27 be correctively amended as follows:

27 (Currently amended): The system of claim ~~27~~ 26, wherein:

No new subject matter is added by these amendments and they clearly put the case into better condition for allowance or for appeal. We accordingly urge that entry is proper.

We proceed now with reference specifically to the numbered items in the Action.

Items 1-4, 7, and 16:

These appear informational in nature and are understood to require no reply.

Items 5-6 (§ 112, ¶2 rejection of claims 12-15 and 26-31):

Responsive to the Examiner's guidance, claims 12, 26, and 30 have been amended in the exact manner suggested. Please note that while the Action indicates that claims 12, 26, and 29 were in need of such amendment, in the case of claim 29 it contains the text providing antecedent basis and it was claim 30 that contained the text felt to improperly reference that antecedent basis. Accordingly it is claim 30 that has been amended.

No new subject matter is added by these amendments.

Items 7-15 (§ 103(a) rejections):

Claims 12-15 and 26-31 are rejected as being unpatentable (obvious) over Subler in view of Hurley. Respectfully this is still error. Except for minor reformatting, the present Action recites the same arguments as the last. In view of this Applicant hereby incorporates by reference the remarks on these rejections from our last Response and asks for reconsideration of these rejections based on the merits of those remarks as well as based on the additional remarks made below in reply to the Response to Arguments section of the present Action.

Item 17 (Response to Arguments):

In Item 17.a the Action states “[i]n response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references” but fails to provide any examples. In a responsive spirit we nonetheless reply.

As is well known:

- (1) it is the responsibility of the Office to establish a *prima facie* case in support of all rejections;
- (2) a *prima facie* case for obviousness based on a combination of references requires that the references in combination teach or reasonably suggest all of the elements and limitations of the claimed invention;
- (3) when the Office asserts that a reference teaches or reasonably suggests an element or limitation of the claimed invention and the reference in fact does not, no *prima facie* case has been established.

To the extent that it may appear that Applicant has attacked references individually, it is believed that this has consistently instead been showings that the Office has not established a *prima facie* case by rebutting specific assertions in the Actions that the Office has relied on to support rejection.

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In Item 17.b the Action states “... *it is noted that the features upon which applicant relies (i.e. on pages 3 and 4 of the Applicants' Response, Applicants argue " **the hard drive based approach recited in claim 12 does not require loading or installing software.***” The nature of the remarks on pages 3-4 of our last Response has apparently been misinterpreted. On pg. 3-4 we take seven assertions made in the last Action, with twelve cites to the Subler reference that are purported to support these assertions, and we rebut that any of those cites actually do support the assertions. In some instances we show that the cites to Subler clearly do not support the assertion (e.g., that something stated to be present in Subler at the cite is clearly not present there). In other instances we show that one of ordinary skill in the art would not interpret what is present at a cite in Subler in the manner that the Examiner has. The examples quoted here are ones showing what Subler does not teach or reasonably suggest, and thus that the Examiner's interpretation is flawed and that this reference (and in turn the combination of references) do not support the present rejection.

20 In Item 17.c the Action states:

In response to Applicants' argument on page 4 of the Applicants' Response that "the Action states that Subler discloses ". [something] (see at least column 5, lines 5-30)." However, the cite does not support the assertion. Col. 5, In. 5-30 merely teaches [something else] ...".

25 *The Examiners [SIC], however disagrees for two reasons:*

i. Applicants stated early in the Applicants' Response ... that Applicants' invention "does not require ...", Which contradicts with Applicants' assertion that Applicants' invention requires [something yet else].

30 *ii. It is noted that the features upon which applicant relies are not recited in the rejected claim(s). ...*

The structure of this argument is bizarre. The last Action asserts that Subler teaches something and Applicant rebutted this by showing that Subler actually teaches something else entirely. Now in Item 17.c.i the Examiner instead in rebuttal argues features of the claimed invention, rather

than what Subler teaches, and in Item 17.c.ii the Examiner further argues that the claims do not recite the features of the invention just argued in Item 17.c.i.

In Item 17.d the Action states:

In Response to Applicants' argument "the Action states that Subler discloses ". transmitting money representing payment for said selection and an identifier associated with said selection from the personal computer to a clearing house, via a communications system (see at least column 3, lines 30-31 and column 4, lines 51-64)." However, this cite also does not support the assertion. Col. 3, ln. 30-31 teaches nothing about transmitting money (in fact, nowhere does Subler teach a financial clearing house). The text in the cite here merely says that items can be paid for. Similarly, col. 4, ln. 51-64 merely teach sending a order to purchase something – not money". (underline added for emphasis and reference, here and throughout)

Here we see that the last Action made a multi-part assertion and cited two locations in Subler as supporting this, and we see that Applicant is rebutting the assertion by showing that the two cited locations in Subler do not support the assertion.

Next the Action states:

However, the Examiner respectfully disagrees. Subler discloses a payment method 430, a card holder, a card number and the card's expiration date (figure 20). Subler further discloses an Accounting Order Entry Marketing Analysis Systems 52 that processes orders accounting/ payment information received from the Order Taking System 42 (figure 1; column 5, lines 19- 30). Subler further discloses that a user must pay for the order before items of interest can be rendered (column 3, lines 28- 33).

Here we see no counter-rebuttal, i.e., that the original cites do actually support the rejection. Instead we see cites to three new locations in Subler in an apparent attempt to salvage the original assertion made in the last Action.

Let us now consider whether the new cites support to the original assertion (“[1] *transmitting money* [2] *representing payment for said selection and* [3] *an identifier associated with said selection* [4] *from the personal computer to* [5] *a clearing house,* [6] *via a communications system*”). The new cites clearly support assertion parts [1] and [2]. They do not explicitly support assertion parts [4] and [6], but one of ordinary skill in the art would at least see the cites as having implied support here. Assertion parts [3] and [5], however, are still not supported even by the new cites to Subler.

Next the Action states “*In other words, Subler discloses an online, cashless payment system (e.g. using s [SIC] credit card); payments for selected items must be cleared/ approved by the card issuer before the user can render the items of interest.*” First, the relevance of this is unclear. Is this an argument that Subler impliedly somehow suggests a clearing house, much less one that is equivalent to the clearing house in Applicant’s claims? It is the responsibility of the Office to clearly articulate rationale in support of a rejection and we are still wanting for such here. Second, that “*payments for selected items must be cleared*” is not supported by the cites, old or new, and appears to be merely unsupported conjecture by the Examiner. Furthermore, this is wrong with respect to many purchases generally. As is well known, purchases below certain price limits (e.g., <\$75 on many credit cards), and purchases made in certain contexts (e.g., payments to medical providers and government entities where payee identity is unquestionable), etc. are not subject to pre-clearance.

In Item 17.e the Action states:

In response to Applicants' arguments with respect to Hurley "the Action states that this "discloses storing an inventory of assets in a hard drive of a personal computer prior to delivery of said personal computer to a user (see at least column 1, lines 8-27)." However, here as well, the Action merely a cites part of a generalized, summarizing statement in a Background of Invention section that does not purport to teach anything. Is this being asserted by the Office to be an enabling teaching?" The Examiner would like to bring to the Applicants attention that the citation (column 1, lines 8-27) states [entire cite quoted]

Apparently the answer is yes.

Next the Action states “A person of ordinary skill in the art would understand that Hurley discloses providing digital content through packaged software stored on storage mediums such as CD ROM or pre-stored/ pre-installed on the hard drive of the computer system (column 1, lines 8-27).” However, the cite nowhere mentions a hard drive or any apparent synonym for such, so how is this an enabling teaching of anything with respect to a hard drive? The inventors in Subler are obviously persons of extraordinary skill in the art, yet they elected not to mention hard drives here, while notably mentioning multiple other storage media, but still none synonymous with or suggestive of a hard drive.

Next – immediately next in the very same paragraph – the Action states

Hurley further discloses that said pre-stored/ preinstalled content are disabled/ locked (e.g. demo or preview copy) and for the user to obtain full access of said content, the user has to request an access/unlock code which unlocks the content (abstract). Therefore, Hurley does clearly disclose the limitation "storing an inventory of assets in a hard drive of a personal computer prior to delivery of said personal computer to a user".

Respectfully, the statement here is nonsense on its face. Hand anybody a copy of the first sentence by itself and then ask them what it teaches or suggests about a hard drive. Furthermore, Hurley does not disclose any of this in col. 1, ln. 8-27, as implied by the Action here.

In Item 17.f the Action states:

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

But this should be compared with what Applicant actually said, which is “*it appears that these advantages can only been seen by the use of 20/20 hindsight based on applicant's disclosure, ...*” (pg. 5, ln 10-12). Accordingly, we stand by our assertion that the Examiner's hindsight has been improper, even by the standard that the Examiner has now cited.

In Item 17.g the Action states:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Respectfully, the Examiner has not rebutted Applicant's argument here. The Examiner has merely asserted that he knows a legal standard, and then failed to even say that he is following that standard.

More importantly, this appears to be in reply to Applicant's statement:

Finally, where in this Action is a reasoned argument articulated for why Hurley's hard drive, or Hurley in general, can reasonably be

combined with Subler? Respectfully, the recent U.S. Supreme Court ruling in KSR International Co. v. Teleflex Inc., clarified many responsibilities of both the Office and of Applicants. One of these is that the Office must at least articulate for the record what reasoning supports references being combined (see e.g., MPEP 2141). This is lacking in this prosecution so far.

This prosecution is still lacking an explanation in the record for how the Examiner's actions in this case meet the legal standard that the Examiner now asserts that he knows.

In Item 17.h the Action states:

In response to Applicants' argument "the Action states "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Subler's teachings to include the step of pre-storing digital content in the computer's hard-drive ..." (underline added). Respectfully this on its face is taking just one step listed in the abstract, out of context and ignoring the rest of the teachings of the reference. Additionally, this states no rationale for substituting Hurley's hard drive in place of Subler's CD-ROM, and still having a workable result in view of the rest of Subler's teachings". However, the Examiner respectfully disagrees.

Subler discloses ...

Hurley ... discloses ...

Therefore, it would have been obvious ... to replace the storage medium (e.g. CD ROM) used by Subler ... with Hurley's storage medium ... to:

i. ensure the compatibility of the digital content with the computer configuration (Subler: column 1, lines 50- 60).

ii. to restrict the usage of the digital content to only one computer hard drive (Hurley: column 2, lines 4- 13).

iii. to reduce the cost of delivering the digital content to the user by not using a storage media such as CD-ROM's (Hurley: column 2, lines 27- 31).

As an initial point of concession, items i-iii above were stated in the last Action without cites to any support and Applicant stated in its last Response that "*neither Subler or Hurley teach these advantages.*" We now see that the newly made cites can be interpreted as support for these assertions.

Nonetheless, the quoted text above is at most an attempt to answer only the first half of the posed question of what is [1] a rationale for substituting Hurley's hard drive in place of Subler's CD-ROM, and [2] still have a workable result in view of the rest of Subler's teachings.

The content of the newly provided cites actually strengthen Applicant's position that the

combination of Subler and Hurley to reject Applicant's claims is improper and further that Applicant's claims are patentable improvements over any Subler and Hurley combination. Subler and Hurley can provide the noted advantages, but only with additional elements/limitations that are incompatible between the two references, thus undermining the appropriateness of combining these references for the rejection here.

Item unnumbered (Conclusion):

This appears informational in nature and is understood to require no reply.

CONCLUSION

Applicant has endeavored to put this case into complete condition for allowance. It is thought that the §112 rejections have all been corrected by amendment and that the §103 rejections have been completely rebutted. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all claims presently in the case be granted.

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Respectfully Submitted,



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